

F. 2d 628, 631, 2 U.S.P.Q.2d 1501, 1503 (Fed. Cir. 1987) *cert denied*, 484 U.S. 827 (1987). WO '532 does not meet this high standard.

It is well settled law that it is the invention as claimed, in its entirety, which must be considered when determining patentability. *Jones v. Hardy*, 727 F.2d 1524, 1530; 220 U.S.P.Q. 1021, 1027 (Fed. Cir. 1984); *In re Hirao and Sato*, 535 F.2d 67, 69, 190 U.S.P.Q. 15, 17 (C.C.P.A. 1976); 35 U.S.C. § 103 (mandating consideration of "the subject matter as a whole"). Indeed, in assessing validity, no claim term may be ignored. Instead each and every claim limitation must be given its proper effect. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Ex parte Grasselli*, 231 U.S.P.Q. 393, 394 (Bd. Pat. App. & Int. 1983).

Claims 1 and 2 include a statement of structure but also properties demonstrated by the high-durability photocatalyst film in terms of light transmittance, haze change, etc. for the substrate film as well as overall properties for the laminated film of total light transmittance of 85% or more, a haze of 5% or less and a water contact angle of 10° or less demonstrating weather resistance. The Official Action does not address these properties but instead argues anticipation more on conjecture than actual fact.

In the Office Action mailed April 21, 2008, page 5, paragraph 6, in response to the information provided by applicants on January 10, 2008, the Examiner states as follows:

"Applicant contends that the prior art does not teach or suggest that the substrate is surface coated with a crosslinking acrylic resin containing an anti-weathering agent as a substrate film.

This is not persuasive as WO '523 disclose on one surface of the substrate that a hardcoat can be formed wherein the hardcoat can be a silicon modified acrylic resin (acrylic resin film), (pages 22-23, lines 5-8). This hardcoat acts the acrylic resin layer containing the anti-weathering agent. Applicant has not provided objective evidence to the contrary that the hardcoat film is not an equivalent to Applicant's acrylic resin film containing an anti-weathering agent."

In the present independent claims 1 and 2, a crosslinking acrylic resin containing an anti-weathering agent, which is surface-coated on an acrylic resin film or a polyethylene terephthalate film to form a substrate film (A), is used for imparting the substrate film (A) with parameters specified in the middle portion of each of these present independent claims 1 and 2. That is:

(1) a total light transmittance of 85 % or more, a haze of 5 % or less and a yellow index (YI) of 10 or less after the accelerated weather resistance test and

(2) a haze change of 1 % or less after the solvent resistance test.

In addition, a protective layer (B) and a photocatalytically active material layer (C) are formed on the substrate film (A), and this combination accordingly provides a high-durability photocatalyst film.

In contrast to the present invention as clearly defined in applicants' claims, WO '523, page 22, line 5 to page 23, line 8, the passage relied upon by the Examiner, discloses hardcoat layers to be formed on a window glass, a plastic board for a window, a CRT display, a flat panel display, etc., and this hardcoat layer contains an inorganic or metal-containing material (e.g., colloidal silica) and an organic resin (e.g., silicon-modified acrylic resin), as will be clear from the attached copy of the relevant pages of US 6,737,145 B1<sup>1</sup> (column 15, line 26 to column 16, line 7) corresponding to WO '523.

Therefore, the hardcoat layer described in WO '523 is material-wise and functionally entirely different from the crosslinking acrylic resin containing an anti-weathering agent which is surface-coated on an acrylic resin film or a polyethylene terephthalate film.

The Examiner takes the position that the hardcoat layer described in WO '523 and the crosslinking acrylic resin containing an anti-weathering agent in the present independent claims 1 and 2 are identical. This is not so -- for the above explained reasons.

Substantially the same comments are pertinent to the rejection of claims 3-7 of alleged "obviousness", the examiner's position with respect to the primary reference not improved by the secondary reference JP '876. In any event, those claims depending from the independent claims are also not made obvious by the document cited because the limitations of an independent claim are incorporated into their dependent claims. MPEP §2143.03.

Reconsideration and allowance are solicited. Should the examiner have any questions or require further information, please contact the undersigned.

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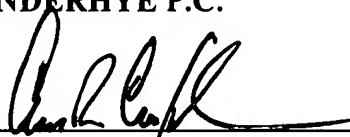
<sup>1</sup> The examiner will note that Messrs. Nakamura and Tanaka, patentees (with others) of U.S. 6,737,145 are also applicants/inventors (together with one other person) of the present application. They are well familiar with their prior work as well as the subject matter of the present application. Also one of the assignees Ube Nitto Kasei Co., Ltd. is one of the assignees of the '145 patent.

NISHIKAWA et al.  
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Respectfully submitted,

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